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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/691,392	10/17/2000	Ronald A. Katz	244/068	3722

29129 7590 10/22/2004

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EXAMINER

MCCLELLAN, JAMES S

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 10/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/691,392	KATZ ET AL.	
	Examiner	Art Unit	
	James S McClellan	3627	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 July 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 21-23,36,39,40,42-50,68-71,75 and 198-223 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-23,36,39,40,42-50,68-71,75 and 198-223 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>8/16/04</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

***Amendment***

1. Applicant's submittal of an amendment was entered on August 6, 2004, wherein:  
claims 21-23, 36, 39, 40, 42-50, 68-71, 75, and 198-223 are pending and  
claims 208-223 have been added.

***Information Disclosure Statement***

2. Applicant's submission of an Information Disclosure Statement on August 16, 2004 has been entered and considered as indicated by the signed copy of the PTO-1449. It is noted that a duplicate references from a previously cited PTO-892 was not initialed. Additionally, numerous NPL/Foreign references were not considered because a copy of the reference was not submitted.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claim 21-23, 36, 39, 40, 42-50, 68-71, 75, and 198-223 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding **claims 21, 68, 217, and 220**, the limitation "at least in part" is unclear. Does the limitation "in part" refer only to "geographic position" or "geographic position", "further data element", and "identity of the user"? Clarification is required.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 21, 22, 36, 39, 40, 42-46, 50, 68-71, 75, 198-211, 214, 217, and 220-222 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,295,064 (Malec et al.).

Regarding **claim 21**, Malec et al. discloses a method for providing at least one offer of an item, the item including at least one of a good and a service, utilizing an electronic communication device (514) enabling communication between an offeror and a user of the electronic communication device comprising the steps of: establishing communication via the electronic communication device (514) between the offeror and the user to enable the user to at least initiate a primary transaction there between (see column 5, lines 7-22); obtaining primary transaction data related to the primary transaction, the primary transaction data including at least data representing an identity of the user (see column 24, lines 40-56) and data representing a geographic position of the user (see column 1, lines 58-66); utilizing the identity of the user to obtain at least a further data element related to the user (see column 24, lines 40-56); utilizing at least in part the geographic position of the user, the at least further data element, and the identity of the user to determine the at least one offer for the item in real time (see column 5, line 16, “immediately”) with the primary transaction, and offering the item to the user (see column 24, lines 40-56 and column 1, lines 58-66); [**claim 22**] the electronic communication device is a

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wireless device (see Figure 4, 504); **[claim 36]** the offer comprises a coupon (see column 24, line 50-52, “coupon”); **[claim 39]** contacting the user via the electronic communications device (514) to offer the at least one item to the user (see column 5, lines 7-22); **[claim 40]** the determination of the at least one offer is subject to negative decision criteria (inherent since the system utilizes user profile and location information, it is inherently negating possible offers); **[claim 42]** the offer is made orally to the user (see column 1, lines 59-61, “visual and aural messages”); **[claim 43]** the offer is made visually to the user (see column 1, lines 59-61, “visual and aural messages”); **[claim 44]** obtaining primary transaction data includes obtaining a geographic identifier representing the geographic position of the user (see column 1, lines 58-66); **[claim 45]** obtaining data from a carrier associated with the electronic communications device (see column 8, lines 41-65); **[claim 46]** obtaining data from a network associated with the electronic communications device (see column 8, lines 41-65); **[claim 50]** offering at least one item related to an entity that is geographically local to the user (inherent); **[claims 208, 209]** obtaining primary transaction data includes the identity of the user (see column 24, line 46, SSN) and geographic position of the user (see column 1, lines 63-64, “location of the cart in the store”).

Regarding **claim 68**, Malec et al. discloses a method for providing at least one offer as set forth in detail for claim 21. **Claims 69-75** are rejected for reasons similar to claims 22, 36, 39, 40, 42-46 as described above in detail.

Regarding claims 198-207, Malec et al. discloses **[claim 198 & 201]** establishing a communication via the electronic communications device includes enabling the user at least to initiate a primary transaction for at least one particular good or service sought by the user (In Malec et al. the user initiates a primary transaction in two way: first, the user travels through the

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store to an aisle that contains a desirable item and second, the user inserts personal identity and history information into the system via smart card); [claims 199, 200, 202, & 203] user provides data to the system (see column 24, lines 40-56); [claim 204 and 206] the data representing the geographic position of the user is communicated electronically from the user to the offeror (see column 6, lines 50-55 and the paragraph bridging columns 8-9; the path of carts through the store is tracked); and [claims 205 and 207] geographic position data is communicated in real-time (see column 5, lines 13-22, "an appropriate message 108 is displayed to the consumer 109 either immediately, or after a time delay").

Regarding **claim 217**, Malec et al. discloses a method for providing at least one offer of an item as set forth in detail for claim 21. **Claims 218 and 219** are rejected for reasons similar to claims 208 and 209 as described above in detail.

Regarding **claim 220**, Malec et al. discloses a method for providing at least one offer of an item as set forth in detail for claim 21. **Claims 221 and 222** are rejected for reasons similar to claims 208 and 209 as described above in detail.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 23, 47, 212, 213, 215, 216, 219, and 223 are rejected under 35 U.S.C. 103(a) as being unpatentable over Malec et al. in view U.S. Patent No. 6,397,057 (Malackowski et al.).

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Regarding **claims 23, 47, 212, 213, 215, 216, 219, and 223**, Malec et al. fails to expressly disclose a wireless phone communication device that utilizes ANI for determining a geographic identifier.

Malackowski et al. teaches the use of advertising system that sends advertisement to user via wireless telephone utilizing ANI data to determine a geographic identifier of the user (see column 11, lines 39-44).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Malec et al. with wireless ANI data as taught by Malackowski et al., because utilizing a wireless phone extends the geographic range of communication between the user and the advertiser.

9. Claims 48 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Malec et al. in view of Official Notice.

Regarding **claims 48 and 49**, Malec et al. fails to expressly disclose a user or an operator manually entering geographic identifying information.

The Examiner takes Official Notice that it was old and well known in the art at the time the invention was made to manually enter geographic identifying information by a user and an operator.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Malec et al. with manually entered location data as is well known in the art, because manually entering the location reduces the operating expense of the advertiser to provide the hardware and software required to electronically determine the location of a user.

*Response to Arguments*

10. Applicant's arguments filed August 6, 2004 have been fully considered but they are not fully persuasive.

On page 11, final paragraph (continued on page 12, second paragraph), Applicant argues that Malec fails to disclose the utilization of three criteria in selecting the offered item (geographic position, further data, and identity of the user. The Examiner respectfully disagrees. In column 1, lines 58-66, Malec clearly discloses the use of geographic position (location within the store) as criteria in selecting the offered item (for example, bread advertisement). In column 24, lines 40-56, Malec disclose the use of further data elements (demographic data) and user identify information (SSN) as criteria in selecting the offered item. All three criteria is clearly disclosed in the Malec reference. All three data elements are used as criteria in selecting the offered item. Malec does limit his disclosure by stating that some data elements are not used together. Malec merely adds additional features (demographic data and user identity data) to his base invention that utilizes user location in the store to select an item to offer.

On page 12, final paragraph (continued on 13), Applicant argues once again that geographic position of the user is not integrated with demographic information and user identity information to select and offer. As set forth above, the Examiner respectfully disagrees. Malec's base invention utilizes geographic position in the store to determine an offer. As indicated in column 24, Malec provides an additional feature that allows the selection of the offer to be further based on various other items including demographic data and user identity data.

On page 13, final paragraph, Applicant argues that Malec does not disclose obtaining data representing a true "geographic position" of the user. The Examiner respectfully disagrees.

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Malec discloses determining the location of shopping cart (and inherently the user associated with the shopping cart) using proximity transmitters 512 (see column 1, lines 58-66). A user's physical location in the store defines a geographic position of the user.

On page 14, item 3, Applicant argues that Malec does not determine its offered item based on the user's geographic position and a further data element. As set forth above, Malec uses various items of information to determine an item to offer, including a user's physical location in a store, demographic data, and user identity data.

Applicant's argument on page 14, item 4, related to the Fano reference is moot in view of the new grounds of rejection.

### *Conclusion*

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jim McClellan whose telephone number is (703) 305-0212. The examiner can normally be reached on Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski, can be reached at (703) 308-5183.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to:

Commissioner of Patent and Trademarks  
Washington D.C. 20231

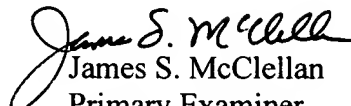
or faxed to:

(703) 872-9306 (Official communications) or

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(703) 746-3516 (Informal/Draft communications).

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,  
Arlington, VA, 7<sup>th</sup> floor receptionist.

  
James S. McClellan  
Primary Examiner  
A.U. 3627

jsm  
October 20, 20044